UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,295	10/28/2003	Lawrence Morrisroe	694231/0051 JJD:IGD	5110

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EXAMINER
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ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 11/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _14 August 2006_.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-18 and 31-33_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-18 and 31-33_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

This office action is in response to the Request for Continued Examination filed August 24, 2006. Claims 1-28 and 31-33 are pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 5 recites the limitation "inserting the conduit file into the empty movie clip". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5-12, 15-21, 24, 25, 27 and 31-33 are rejected under 35 U.S.C. 102(b) as being anticipated by "The HotMedia Architecture: Progressive and Interactive Rich Media for the Internet; Kumar et al. ;IEEE Transactions on Multimedia Vol. 3 No. 2 June 2001 (herein after Kumar)

Regarding claims 1 and 33, Kumar teaches combining an ad input file (media data) with a conduit file (tracking token) to create an integrated ad file (rich-media content with tracking info); containing computer code for providing the ad (interactive rich media) and serving the

integrated ad file from a computer (server) to provide the ad (dynamically generated page) (see fig. 3, pp 255-256, fig. 15 &16 and page 264-266).

Regarding claims 5 and 6, Kumar teaches the input file includes an empty movie object and inserting the conduit file in the empty movie object; wherein the empty movie clip is given a predefined name and searching for the predefined name (media frames) (see pp 256-257).

Regarding claims 7-10, Kumar teaches the ad including one or more actions for linking to one or more web pages where in the integrated ad file includes html code loading a JavaScript file (pp 253-254 and fig. 5), for loading the integrated ad file; the html code including a variable and the conduit file includes code that determined where the ad opens in a parent window or new window based on the variable (see pp 257, 262).

Regarding claims 11, 12, 15, 16, 24 and 25, Kumar teaches identifying a first file (media data); identifying a second file (tracking data) identifying a placeholder in the first file (media frame) and electronically inserting the second file in the placeholder to create an ad file (a hot-media file including the header, thumbnail, media, meta or endofstream); wherein the first file specifies ad content code and the second file contains ad-tracking code (see pp 256-257, 263-265).

Regarding claims 17-21 and 27, Kumar teaches the first placeholder is empty movie object (see pp 256-257); comprising html code for loading the third file (see pp 257, 262); wherein the third file includes one or more buttons corresponding to links to one or more web pages where in the integrated ad file includes html code loading a executable program; web-based application (pp 253-254 and fig. 5), for loading the integrated ad file; the html code

including a variable and the conduit file includes code that determined where the ad opens in a parent window or new window based on the variable (see pp 257, 262).

Regarding claim 31 and 32, Kumar teaches the integrated ad file includes one or more exit code referring to one or more URL variables; wherein the integrated ad file is designed to be loaded and wherein the ad is provided (see pp 257-262).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2-4, 13, 14, 22, 23, 26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over kumar et al.

Regarding claims 2, 3, 13, 14, 22, 23 and 28, Kumar teaches the HotMedia customizing at the time of content creation of information to be tracked and ability to choose a subset of information to be tracked out as per the goals of the campaign or the preferences of the tracking server and interface with many tracking servers and ability of disabling tracking if needed. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to known that Kumar would accept a new or modified information or content from the source and insert the same or different tracking information according to the goals of the campaign or the preference of the tracking server.

Regarding claims 4 and 26, Kumar does not explicitly teach the use of Flash ad, however

official notice is taken that is old and well known in the art at the time of the invention to use a

well known program such as, Macromedia's Flash program. Flash enables users to generate

computer graphics and animations in the form of compressed audio and video files (.swf files),

which can be executed by a Flash Player.TM program. One would be motivated to use a well-

known program that is executable as a standalone application or as a Plug-in program that is

available on a variety of platforms for a variety of Web Browsers to create the file.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

Kaminsky et al. (US 2002/0124246) teaches tracking distribution of information to

viewers by inserting tracking information to the information.

Kocal (US 2002/0116494) teaches embedding link-tracking code in each web page and

logging into a link-tracking server.

Lipscomb et al. (US 6,693,649) teaches inserting tracking code in a hot media

presentation file.

Wodarz et al. (US 5,999,912) teaches dynamic advertising scheduling display and

tracking.

Leading On-line Advertising Agencies Use IBM HotMedia in Next Generation

Campaigns; IBM Press room – 1998-10-26; New York;

http://www-03.ibm.com/press/us/en/pressrelease/20408.wss

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RETTA YEHDEGA
PRIMARY EXAMINER

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